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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/064,146 | 06/14/2002 | Mark A. Kappel | 126063 | 3242 |
| 27256 | 7590 | 05/05/2006 | EXAMINER | |
| ARTZ & ARTZ, P.C. 28333 TELEGRAPH RD. SUITE 250 SOUTHFIELD, MI 48034 | | | PHAN, THIEM D | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 3729 | |

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/064,146 | KAPPEL ET AL. |
| | Examiner Tim Phan | Art Unit 3729 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 10-12 is/are rejected.
- 7) Claim(s) 9,13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. The amendment filed on 2/14/06 has been fully considered and made of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Greco (US 4,215,468).

As applied to claim 1, Greco teaches an IC extracting tool, comprising:

- a piston assembly (Fig. 6, 10) having a channel therethrough (Fig. 11, around 48, 41 & 22);
- a cross-member (Fig. 6, 22) slidably receiving said piston assembly, said cross-member having a slot for pins (Fig. 7, 23) therein, said cross-member having a post head (Fig. 7, 20) sized to be received within a retraction feature (Figs. 1-2); and
- a pin (Fig. 7, 30) positioned within said channel and slidably received within said slot.

As applied to claim 2, Greco teaches a piston (Fig. 6, 43) having a first and second end (Fig. 6, ends of 43).

As applied to claim 3, Greco teaches that the piston assembly has a handle (Fig. 6, 40) disposed on a first end.

As applied to claim 4, Greco teaches that a channel (Fig. 11, around 41 & 22) is disposed on a second end of the piston (Fig. 11, bottom of 43).

As applied to claim 5, Greco teaches that the piston assembly comprises a grip (Fig. 6, 33) having an opening (Fig. 6, around 41) therethrough for slidably receiving said piston (Fig. 6, 43) therethrough.

As applied to claim 6, Greco teaches a spring (Fig. 6, 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip.

As applied to claim 7, Greco teaches a first and second post (Fig. 7, 20).

As applied to claim 8, Greco teaches that the pin (Fig. 7, 30) has an angular shape.

As applied to claim 10, Greco teaches an IC extracting tool, comprising:

- a piston (Fig. 6, 43) having a handle (Fig. 6, 40) disposed on a first end and a channel (Fig. 11, around 41 & 22) disposed on a second end;
- a grip (Fig. 6, 33) having an opening (Fig. 6, around 41) therethrough for slidably receiving said piston;
- a spring (Fig. 6, 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip;

- a sleeve (Fig. 11, 12) adjacent to the grip for slidably receiving the piston;
- a cross-member (Fig. 7, 22) adjacent to said sleeve, said cross-member having a slot (Fig. 7, 23) therein, said cross-member having a post head (Fig. 7, 20) sized to be received with a retraction feature (Figs. 1-2); and
- a pin (Fig. 7, 30) positioned within said channel and slidably received within said slot.

As applied to claim 11, Greco teaches that the post comprises a first post and a second post (Fig. 7, 20).

As applied to claim 12, Greco teaches that the pin (Fig. 7, 30) has an angular shape.

Allowable Subject Matter

4. Claims 9 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicants' arguments filed on 2/14/06 have been fully considered but they are not persuasive for the following reasons:

In response to applicants' citations (Remarks, pages 6 & 7) of the limitations of the claimed tool by numbering each of them in order to differentiate them from the prior art Greco, it is noted that the features upon which applicant relies (i.e., numbering) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants urge that Greco does not teach the retraction feature (Remarks, page 7, last paragraph – page 8, 1st paragraph), Greco does indeed teach the retraction feature of the tool as shown in Figures 1 to 2.

It appears that Applicants fail to recognize the scope of the claims when judged in view of Greco. (Cf. MPEP 2111 and *In re Geuns*, 26 USPQ 2nd 1057 (Fed. Cir. 1993)).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
May 1, 2006



A. DEXTER TUGRANG
PRIMARY EXAMINER